

Applicants' response submitted on September 24, 2003. As stated in that response, Forward has a publication date of June 10, 2003 and the present application has a filing date of December 19, 2000. Title 35 USC §102(b) states a person shall be entitled to a patent unless the invention was patented or described in a printed publication in this or a foreign country, more than one year prior to the date of the application for patent in the United States. Since Forward was patented and described in a printed publication more than two years after the submission date of the present application, Forward does not qualify as a prior art reference under 35 USC §102(b).

MPEP §706.07(a) states that a second or subsequent action on the merits shall be final except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement (IDS) filed during the period set forth in 37 CFR §1.97(c). In the present case, the only subsection of 35 USC §102 for which Forward may potentially qualify as prior art is 35 USC §102(e). A rejection under 35 USC §102(e) is necessarily a new ground of rejection with respect to a prior rejection under 35 USC §102(b). Moreover, Applicants did not amend the claims in their response submitted September 24, 2003 and have not filed an IDS during the

applicable period set forth in 37 CFR §1.97(c). Therefore, withdrawal of the finality of the present rejections is warranted.

For the purpose of expediting the prosecution of this application, Applicants will treat the present rejections as though they are based on 35 USC §102(e). And as such, Applicants respectfully traverse these rejections.

Claim 1 recites:

A real estate transaction managing system enabling a host to selectively provide rebate coupons to potential buyers of real property, said system comprising:

at least one remote communications facility including at least one input-output means; and

a host system including (i) data storage means for maintaining databases containing a plurality of data records of differing types and chronologies, (ii) computer processing means for selecting data records and transmitting said selected data records to said at least one remote communications facility according to selection criteria provided by said at least one remote communications facility, wherein said computer processing means registers and stores in said databases first rebate coupons, second rebate coupons and information relating to real estate properties and (iii) communications network means for being controlled by said computer processing means to exchange data between said host computer system and said at least one remote communications facility including transmitting said selected data records to said at least one remote communications facility, wherein:

(a) a potential buyer, without the aid of a field agent, uses said at least one input-output means to do one of:

(i) specify said selection criteria for said data records, obtain display of selected data records meeting said selection criteria, and obtain one of said

first coupons from said host system for at least one property corresponding to said selected data records, said one of said first coupons being one of already registered or capable of being subsequently registered with the host system when received by said potential buyer, or
(ii) present to the host at least one second rebate coupon, that is obtained from a communications medium other than said host system, using a first indication that is provided on said at least one second rebate coupon and receive from the host system an approval comprising a second indication, wherein said first coupon and said second coupon are defined by said host system such that (i) a seller has already agreed to or (ii) a seller is to subsequently agree to perform an acceptance of said first rebate coupon or said at least one second rebate coupon from a potential buyer as a substitute for an agent in the field, and to fund a commission to said host for the sale of a property corresponding to one of said first rebate coupon or said at least one second rebate coupon that is subject to said acceptance.

Forward fails to disclose the features recited in claim 1 of: (1) first and second rebate coupons that are defined by a host system such that a seller accepts the rebate coupon from the buyer as a substitute for an agent in the field, (2)(a) an input-output means that obtains one of the defined first coupons from the host system or (2)(b) an input-output means that presents to the host system the defined second rebate coupon using a first indication that is provided on the second rebate coupon, and (3) a computer processing means of the host system that registers and stores in databases the defined first and second rebate coupons.

Instead, Forward discloses in Figs. 1-4 a method for directing and instructing customers to deal with specific merchants using incentives (Forward, title of the invention). This method operates as follows. A buyer 10 transmits an information request 26 to an item locator system 12 (S202) (col. 4, lines 13-14). In response to the potential buyer's request for information, item locator system 12 provides item information 28 and incentive information 29 (S204) (col. 4, lines 23-26). Upon locating the specific item information and corresponding incentive information 29 desired, a potential buyer contacts the seller using the information provided in item information 28 (S206) (col. 5, lines 41-44). Based on this contact, buyer 10 and a specified seller 24 create a contract 30 for the purchase of the desired item (S208) (col. 5, lines 50-51). As part of contract 30, buyer 10 receives a purchase certification 32 (S210) (col. 5, lines 61-62). Purchase certification 32 may comprise a copy of the contract, an identification number, a signature, or any other method of certifying that the buyer and seller formed a contract for the purchase of the item at issue (col. 5, lines 62-66).

After receiving purchase certification 32 from the seller, the buyer transmits an incentive execution request 34 along with purchase certification 32 to item locator system 12 (S212) (col.

6, lines 4-6). Item locator system 12 transmits a request 38 for the fee or commission from the seller identified in purchase certification 32 (S214) (col. 6, lines 30-32). In response, the seller transmits a commission/fee 40 to item locator system 32 as agreed (S216) (col. 6, lines 32-34). Then, item locator system 12 may provide an incentive execution 36 to the buyer (S218) (col. 6, lines 42-43).

The Final Rejection analogizes Forward's incentive execution 36 to the claimed first rebate coupon (Final Rejection page 2, last paragraph). With regard to this feature, Forward discloses that an item locator system 12 may provide incentive execution 36 to a buyer (Forward col. 6, lines 42-43). The incentive execution may comprise an electronic certificate, identification number, check, coupon, or any other device that the buyer may use to execute the incentive indirectly with a third party (col. 6, lines 43-47). Alternatively, in step 218, item locator system 12 may deliver the incentive directly (col. 6, lines 47-48). For example, if the incentive is cash, then item locator system 12 may transmit electronic payment of the cash to the buyer (col. 6, lines 48-50).

In summary, Forward does not disclose that a seller accepts incentive execution 36 from a buyer as a substitute for an agent in the field. By contrast to the claimed feature, Forward's

incentive execution 36 is not provided to the buyer until the purchase contract is complete and the operator of item locator system 32 has received a commission for bringing the buyer and seller together for the completed sale. Moreover, Forward does not disclose that the seller accepts the incentive execution 36, as would be required by claim 1; instead, the buyer receives it. Furthermore, Forward does not disclose that the buyer provides incentive execution 36, as would be required by claim 1. Instead, Forward discloses that the buyer receives incentive execution 36.

Therefore, Forward does not disclose the feature recited in claim 1, as proposed in the Final Rejection, whereby the first rebate coupon is defined by the host system such that a seller accepts the first rebate coupon from the buyer as a substitute for an agent in the field. Since Forward does not disclose the first rebate coupon defined in claim 1, Forward necessarily cannot disclose a computer processing means of a host system that stores and registers the defined first rebate coupon in databases and an input-output means that obtains the defined first rebate coupon from the host system.

The Final Rejection analogizes the claimed second rebate coupon to Forward's purchase certification 32 (Final Rejection, sentence bridging pages 2 and 3). As described above, Forward

discloses that as part of a contract for the purchase of an item, a buyer receives a purchase certification 32 (Forward col. 5, lines 50-52 and 60-62). Purchase certification 32 may comprise a copy of the contract, an identification number, a signature, or any other method of certifying that the buyer and seller formed the contract for the purchase of the item (col. 5, lines 62-66).

As disclosed by Forward, purchase certification 32 comes into existence upon the formation of a contract to certify that the contract was formed (see col. 5, lines 61-66). Purchase certification 32 is not defined by a host system such that a seller accepts it from a buyer as a substitute for an agent in the field. Once the contract is formed, an agent would be of no use to the buyer or the seller. Therefore, there is no reason for the seller to accept something certifying the existence of the contract from the buyer, as a substitute for the agent, since the need for the agent is extinguished by the formation of the contract. Moreover, Forward does not disclose that the seller accepts purchase certification 32 from the buyer, as would be required by claim 1. Instead, Forward discloses that the buyer accepts purchase certification 32 from the seller. Furthermore, a document certifying (i.e., Forward's purchase certification) that a buyer and seller have formed a contract for the purchase of an item is not identical or even similar to a rebate coupon.

The terms rebate coupon and purchase certification have different meanings that are not confused by people in their common usage.

Therefore, Forward does not disclose the feature recited in claim 1, as proposed in the Final Rejection, whereby the second rebate coupon is defined by the host system such that a seller accepts the second rebate coupon from the buyer as a substitute for an agent in the field. Since Forward does not disclose the second rebate coupon defined in claim 1, Forward necessarily cannot disclose an input-output means that presents the defined coupon to a host system using a first indication provided on the coupon. For the same reason, Forward necessarily cannot disclose a host system having a computer processing means that registers and stores in databases the defined second rebate coupon.

In accordance with the above discussion, Applicants submit that Forward fails to disclose all of the features recited in claim 1. More specifically, Forward does not disclose: (1) first and second rebate coupons that are defined by a host system such that a seller accepts the rebate coupon from the buyer as a substitute for an agent in the field, (2) (a) an input-output means that obtains one of the defined first coupons from the host system or (2) (b) an input-output means that presents to the host system the defined second rebate coupon using a first indication that is provided on the second rebate coupon, and (3) a computer

processing means of the host system that registers and stores in databases the defined first and second rebate coupons.

Therefore, allowance of claim 1 and all claims dependent therefrom is warranted.

Claim 17 recites:

A method of automatically generating and issuing real estate buyer rebate coupons to potential buyers through a communications network, said method comprising:

employing a host system for signing up sellers to pay a commission to one of the host for each buyer delivered to a builder, and other seller through the host's systems that eventually purchases a home from that builder or other seller;

obtaining a listing inventory of property to be sold with a buyer rebate funded by the host;

maintaining databases at the host which contain data records of different types and chronologies;

providing by the host system to remotely accessing users access via the communications network to specify selection criteria;

searching by the host system said maintained databases based on said selection criteria; and

delivering results of the searching step to the remotely accessing users;

providing by the host the ability to select properties to tour from the delivered results; and

processing rebate coupons by the host for properties selected to tour.

Title 37 CFR §1.104(c) (2) states that when a reference applied in a rejection is complex or describes inventions other than that claimed by applicant, the particular part relied on must be designated as nearly as practicable. Also, the pertinence of the reference, if not apparent, must be clearly

explained. 37 CFR §1.104(c)(2); see also *Ex parte Ionescu*, 222 USPQ 537, 539 (Bd. Pat. App. 1984) ("When a claim is rejected, the examiner should explain clearly the reasons for the rejection.").

In the rejection of claim 17, the Final Rejection merely recites features of the claim, concludes that Forward discloses these features, and cites col. 3, line 52, through col. 8, line 33, of Forward's disclosure for providing this disclosure (Final Rejection section 9, first paragraph). The cited portion describes multiple embodiments of Forward's invention, and the Final Rejection provides no clear indication which one of these embodiments is proposed to anticipate the invention defined by claim 17. With the exceptions described below, the Final Rejection provides no discussion of how Forward discloses the claimed features or what features disclosed by Forward correspond to the claimed features. Therefore, Applicants submit that a *prima facie* case of anticipation has not been established with respect to claim 17. For similar reasons, Applicants submit that a *prima facie* case has not been established with respect to claim 1. Therefore, allowance of claims 1 and 17 and all claims dependent therefrom is warranted.

Regarding the above-mentioned features of claim 17 that are discussed with greater specificity, the Final Rejection proposes

that the claimed features of (1) issuing real estate buyer coupons to potential buyers through a communication network and (2) processing the rebate coupons by a host system for properties selected to tour are anticipated by Forward's disclosure of (1) providing by the host the ability to select properties to tour and (2) processing rebate coupons by the host for properties selected to tour (Final Rejection page 3, second paragraph). However, the Final Rejection fails to describe how Forward's proposed disclosure of providing, by the host, the ability to select properties to tour corresponds to the claimed feature of issuing real estate buyer coupons to potential buyers through a communication network. The proposed ability to select properties to tour through a host does not require or imply that a communication network issues real estate buyer coupons to potential buyers. In short, there is no clear correspondence between the claimed feature and the feature proposed to anticipate it.

In the discussion provided in the preceding paragraph, Applicants presume the Final Rejection intended for proposed feature (1) to correspond to claimed feature (1) and proposed feature (2) to correspond to claimed feature (2). This presumption is made because proposed feature (2), as recited in the Final Rejection, has nearly identical wording to claimed

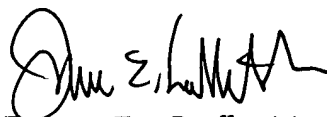
feature (2), as recited in the Final Rejection. However, whatever the intent of the Final Rejection, the proposed feature of processing rebate coupons by a host system for properties selected to tour also does not anticipate the claimed feature of issuing real estate buyer coupons to potential buyers through a communication network. The proposed processing of rebate coupons by a host system for properties selected to tour does not require or imply the claimed feature of issuing real estate buyer coupons to potential buyers through a communication network. Simply put, there is no clear correspondence between the claimed feature and a feature within Forward's disclosure.

Since Forward fails to disclose issuing real estate buyer coupons to potential buyers through a communication network, Forward necessarily cannot disclose processing the issued rebate coupons by a host system. Accordingly, Forward does not disclose all of the features recited in claim 17. Therefore, allowance of claim 17 and all claims dependent therefrom is warranted.

In view of the above, it is submitted that this application is in condition for allowance and a notice to that effect is respectfully solicited.

If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to telephone the undersigned at the local Washington, D.C. telephone number listed below.

Respectfully submitted,



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JEL/DWW/att

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